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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,318	06/19/2001	Yasushi Hara	P/1912-23	4595
7590	08/18/2004		EXAMINER	
STEVEN I. WEISBURD DICKENSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS 41ST FLOOR NEWYORK, NY 10036-2714			BELLO, AGUSTIN	
			ART UNIT	PAPER NUMBER
			2633	q
			DATE MAILED: 08/18/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/885,318	HARA ET AL.	
	Examiner	Art Unit	
	Agustin Bello	2633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 June 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-5 and 9-14 is/are rejected.

7) Claim(s) 6-8 and 15-17 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art admitted by the applicant (Figure 3 of the drawings) in view of Segaram (U.S. Patent No. 5,822,325).

Regarding claims 1 and 10, the admitted prior art teaches a circuit for preventing transmission of a fixed pattern of an optical digital transmission equipment, comprising: a memory (reference numeral 102 in Figure 3) for temporarily accumulating a low-order group signal (reference numeral 101 in Figure 3), a multiplexing circuit (reference numeral 110 in Figure 3) for multiplexing an output signal output by said memory with an overhead bit necessary for optical digital transmission. The admitted prior art differs from the claimed invention in that it fails to specifically teach a pattern generation circuit for generating an unfixed pattern having no fixed value and outputting the pattern to said multiplexing circuit. However, coupling a pattern generation circuit generating an unfixed pattern to a multiplexer is well known in the art. Segaram teaches coupling a pattern generation circuit (reference numeral 130 in Figure 2) for generating an unfixed pattern having no fixed value (e.g. random data signal column 3 lines 7-11) and outputting the pattern to said multiplexing circuit (reference numeral 330 in Figure 2). One skilled in the art would have been motivated to couple a pattern

generation circuit for generating an unfixed pattern having no fixed value and outputting the pattern to said multiplexing circuit of the admitted prior art in order to prevent unauthorized downstream ports from receiving the data signal. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to couple a pattern generation circuit for generating an unfixed pattern having no fixed value and outputting the pattern to said multiplexing circuit as taught by Segaram in the transmitter of the admitted prior art.

Regarding claim 2, the combination of references teaches that said unfixed pattern (e.g. random pattern of Segaram) is applied to said multiplexing circuit while said memory outputs a fixed pattern (reference numeral 109 in Figure 3 of the admitted prior art).

Regarding claims 3 and 12, the combination of references teaches a selection circuit (reference numeral 240 in Figure 2 of Segaram) connected to said multiplexing circuit and said memory (reference numeral 102 in Figure 3 of the admitted prior art), wherein between said fixed pattern output by said memory and said unfixed pattern output by said pattern generation circuit, said selection circuit selects said unfixed pattern (e.g. random pattern selected when necessary). The combination of references differs from the claimed invention in that it fails to specifically teach that the selector is between the multiplexer and the memory. However, one skilled in the art would clearly have recognized that a selector positioned between the memory and the multiplexer would have been beneficial in that it would have allowed the selection of the signal to be input to the multiplexer. Furthermore, Segaram suggests this concept in that the selector (reference numeral 240 in Figure 2) works in conjunction with the multiplexer to select a single signal to be input to the multiplexer. Therefore, it would have been obvious to one skilled

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in the art at the time the invention was made to have positioned the selector of taught by Segaram between the memory and the multiplexer in the combination of references.

Regarding claims 4, 5, 13, and 14 the combination of references and the admitted prior art in particular teaches a phase comparator (reference numeral 115 in Figure 3) for outputting a reset signal which resets said memory based on a phase difference between a phase of write to said memory and a phase of read from the memory. The combination of references differs from the claimed invention in that it fails to specifically teach that said selection circuit selects said unfixed pattern based on said reset signal. However, one skilled in the art would clearly have recognized that since the memory outputs a fixed pattern after a reset, information from the memory not intended to be transmitted to a distant receiver would be output. As such, one skilled in the art would clearly have recognized that the system of Segaram provides a means for interrupting the transmission of unintended data by instead selecting random data to be input and output from the multiplexer. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to select unfixed pattern data (e.g. random) based on said reset signal in the combination of references.

Regarding claims 9 and 11, the combination of references teaches that the unfixed pattern is random (column 3 lines 7-11).

Allowable Subject Matter

3. Claims 6-8 and 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed 6/4/04 have been fully considered but they are not persuasive. The applicant argues the examiner has failed to establish a *prima facia* case. However, the examiner disagrees. The examiner has cited references that meet the limitations of the claimed invention and has provided motivation has been given for combining the cited references.

5. In response to applicant's argument that Segaram is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Segaram is in the same field of communication.

6. In response to applicant's argument that Segaram fails to teach the suppression of unwanted DC components, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., suppression of unwanted DC components) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosen, Kendall, Tominaga, Lafferty, and Urbansky present relevant art.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

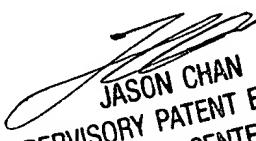
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agustin Bello whose telephone number is (703)308-1393. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (703)305-4729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB



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